REMARKS

The Examiner rejected claims 1, 2, 6-9, 11, 12, and 36. Applicants cancelled claims 1, 2, 6-9, 11, and 12 herein without prejudice. Thus, claim 36 remains pending.

In light of the following remarks, Applicants respectfully request reconsideration and allowance of claim 36.

Obviousness-type double patenting rejections

The Examiner rejected claims 1, 2, 6-9, 11, and 12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 6-10 of U.S. Patent No. 6,500,630. Applicants respectfully disagree. To further prosecution, however, Applicants cancelled claims 1, 2, 6-9, 11, and 12 herein without prejudice. Thus, this rejection is moot.

Rejections under 35 U.S.C. 112, first paragraph

The Examiner rejected claims 1, 2, 6-9, 11, and 12 under 35 U.S.C. § 112, first paragraph for lack of enablement. Applicants respectfully disagree. Applicants' specification fully enables a person having ordinary skill in the art to make and used the claimed invention. To further prosecution, however, Applicants cancelled claims 1, 2, 6-9, 11, and 12 herein without prejudice. Thus, this rejection is moot.

Rejection under 35 U.S.C. § 103(a)

The Examiner rejected claims 1, 2, 6, 8, 9, 11, and 12 under 35 U.S.C. § 103(a) as being unpatentable over the Jacot *et al.* reference (*Endocrinol.*, 139:44-50 (1998)) in view of the Bersinger *et al.* reference (*Brit. J. Obstet. Gynaecol.*, 91:1245-1248 (1984)) as evidenced by the Lawrence *et al.* reference (*Proc. Natl. Acad. Sci. USA*, 96:3149-3153 (1999)). Applicants respectfully disagree. The cited references do not render the claimed invention obvious. To further prosecution, however, Applicants cancelled claims 1, 2, 6, 8, 9, 11, and 12 herein without prejudice. Thus, this rejection is moot.

The Examiner also rejected claim 36 under 35 U.S.C. § 103(a) as being unpatentable over the Bersinger *et al.* reference (*Brit. J. Obstet. Gynaecol.*, 91:1245-1248 (1984)) in view of the Epstein *et al.* reference (*Proc. Natl. Acad. Sci. USA*, 89:10435-10439 (1992)), the Harlow and Lane reference (Antibodies: A Laboratory Manual, 1988, Cold Spring Harbor Laboratory, p. 313), and the Oxvig *et al.* reference (*J. Biol. Chem.*, 268:12243-12246 (1993)). Specifically, the Examiner stated that:

> The suggestion to make said antibodies comes from Oxvig et al wherein they state that, commercially available polyclonal anti-PAPP-A is polyspecific, also reacting with MBP (Abstract). Thus, one of skill would be motivated to make, using the reverse immunoaffinity purification method of Epstein et al, antibodies that are specific for PAPP-A vs the PAPP-A/MBP complex. Furthermore, one of skill would be motivated to use said purified antibodies to detect PAPP-A because they would not recognize the PAPP-A/MBP complex.

Applicants respectfully disagree. The Oxvig *et al.* reference fails to suggest that a person having ordinary skill in the art should carry out the presently claimed invention. In fact, at no point does the Oxvig *et al.* reference teach or suggest that a person having ordinary skill in the art should make the recited antibody, let alone use the recited antibody to detect PAPP-A in a biological sample according to claim 36. Merely pointing out that commercial anti-PAPP-A preparations react with MBP "and probably with proMBP" (Oxvig *et al.* at page 12246) falls far short of suggesting that a person having ordinary skill in the art should use an antibody having specific binding affinity for PAPP-A, but not PAPP-A/pro major basic protein complex, as recited in claim 36. Applicants note that the Federal Circuit warns that the suggestion "must be founded in the prior art, not in the applicant's disclosure," and that "it is impermissible to use the claimed invention as a 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *See, In re Dow Chemical Co.*, 837 F.2d 469 (Fed. Cir. 1988) and *In re Fritch*, 972 F.2d 1260 (Fed Cir. 1992).

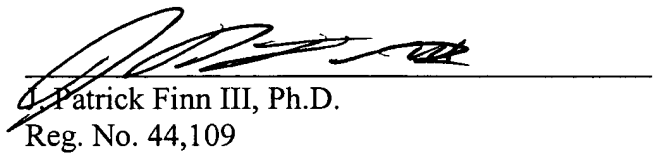
In light of the above, Applicants request withdrawal of the rejection of claim 36 under 35 U.S.C. § 103(a).

CONCLUSION

Applicants submit that claim 36 is in condition for allowance, which action is respectfully requested. The Examiner is invited to telephone the undersigned attorney if such would further prosecution. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: April 18, 2005



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